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09/755,898

01/05/2001

Mark Miller Chesser

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RATHE PATENT & IP LAW  
10611 W. HAWTHORNE FARMS LANE  
MEQUON, WI 53097

EXAMINER

DOAN, DUYEN MY

ART UNIT

PAPER NUMBER

2152

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DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                        |  |                      |  |
|------------------------------|------------------------|--|----------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> |  | <b>Applicant(s)</b>  |  |
|                              | 09/755,898             |  | CHESSER, MARK MILLER |  |
|                              | <b>Examiner</b>        |  | <b>Art Unit</b>      |  |
|                              | Duyen M. Doan          |  | 2152                 |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 September 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3-6,12-14,16-20,22-25,29,30,37 and 40-60 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-6,12-14,16-20,22-25,29,30,37 and 40-60 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 January 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

***This office action is in response to submission filed on 9/18/2006. Claims 1,3-6,12-14,16-20,22-25,29-30,34-37,40-45 are amended for examination. Claims 46-60 are newly added. Claims 2,7-11,15,21,26-28,31-33,38-39 are cancelled.***

### ***Response to Arguments***

Applicant's arguments filed 9/18/2006 have been fully considered but they are not persuasive.

As regarding applicant's argument that the prior art does not teach "associating at least one output character with a user entry button on a device, the device is a wireless internet enabled device, storing user specified output characters associated with plurality of user entry buttons" examiner respectfully disagrees, Mark discloses a method of inputting a telephone number (input code) using the key pad (entry buttons), utilizing a outcall database to store user specified messages (output characters) associated with the telephone number (input code using key pad of the device). Every time the user enters a telephone number (input code) using the keypad of the device (buttons), the telephone number will route to the database, the database will associate the character message with the telephone input by the user. Mark does not explicitly disclose the device is the wireless device, however Bauer discloses the similar concept

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of inputting some code (i.e. file name) using a wireless device such as wireless telephone or PDA (these device are internet enabled) (see Bauer col.4, lines 54-67), the system will output a character file matching the input code (file name). The combination of Mark and Bauer discloses the claimed invention of claims 1,20,37,40-41.

As regard to application's argument regarding "no reason to modify Mark with Bauer", examiner disagrees, both Mark and Bauer discloses the concept of inputting some input code, associating this input code with some output characters. It does not matter what the input code would be, the input code can be anything inputted into the system using a device with key buttons. Therefore it is obvious to modify Mark with Bauer to produce the present invention.

As regard to applicant's argument that the prior art does not teach "a web communicating input device...using a world wide web to input the input code...output character in a field of an email" examiner disagrees, as mentioned above, Bauer discloses using a wireless web enable to input a code such as file name. Mark discloses the pre-recorded message can be utilized in an email system, where instead of voice message the text message will be used to send email to the recipient.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 48-50,53-55,58-60 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 48-50,53-55,58-60 cited "the input code exclude a telephone number, the input code is not transmitted to the application program". Examiner finds no support for these limitations throughout the specification. Applicant added these new claims to overcome the cited prior arts, however, these limitations are not support by the applicant's specification.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

As regard to claims 48-50,53-55,58-60, applicant define the invention in terms of what it was not, rather than pointing out the invention, thus limitations "the input code exclude a telephone number, the input code is not transmitted to the application

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program" was a negative limitation that rendered the claim indefinite because it was an attempt to claim the invention by excluding what the inventors did not invent rather than distinctly and particularly pointing out what they did invent.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1,3-6,12-14,16-20,22-25,29,30,37 and 40-60 are rejected under 35

U.S.C. 103(a) as being unpatentable over Markowitz et al (us pat 6295346) (hereinafter Mark) in view of Bauer et al (us pat 6751603) (hereinafter Bauer).

**As regarding claims 1,20,37**, Mark discloses the input code associated with one of the plurality of user entry buttons and representing user input by activation of the user entry button (see Mark col.3, lines 26-38; col.4, lines 6-45; col.7, lines 27-58, inputting the unique code using the telephone keypad, this unique code associate with the pre-recorded message that store at the service provider); locating in a programmable device at least one user-specified output character associated with user entry button, in response to receipt of the input code, the programmable device storing a plurality of user-specified output characters associated with the plurality of user entry button(see

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Mark col.3, lines 26-38; col.4, lines 6-45; col.7, lines 27-58, inputting the unique code using the telephone keypad, this unique code associate with the pre-recorded message that store at the service provider, the database at the service provider stores pre-recorded message associated with each individual); and providing said at least one user-specified output character for use by an application program (see Mark col.3, lines 26-38; col.4, lines 6-45, lines 54-67; col.7, lines 27-58).

Mark discloses the invention substantially as claimed, but fail to disclose receiving an input code from the wireless Internet-enabled device via a web interface of a server computer.

Bauer teaches receiving an input code from the wireless Internet-enabled device via a web interface of a server computer (see Bauer col.2, lines 54-60; col.4, lines 30-36; col.6, lines 15-38, using the mobile phone or any wireless to perform an action on the interface of the server computer by inputting the string character = input code).

It would have been obvious to one with ordinary skill in the art at the time the invention was made to combine the teaching of Bauer to the method of Mark to use the wireless Internet enabled device via a web interface of a server computer because by using the wireless device to input the code through the interface of the server computer would accelerate and facilitate the process of finding data file in a computer system (see Bauer col.1, lines 8-21).

**As regarding claims 3, 22,** Mark-Bauer discloses receiving said input code via a web interface comprises receiving the input code from a data communications network

(see Bauer col.4, lines 31-35). The same motivation utilized in claim 1 applied equally well to claim 3, 21-22.

**As regarding claims 4-5, 23-24**, Mark-Bauer discloses receiving the input code from the web interface comprises receiving the input code from a wireless communication system (see Bauer col.4, lines 31-35 and col.6, lines 33-38). The same motivation utilized in claim 1 applied equally well to claims 4-5,23-24.

**As regarding claim 6 and 25**, Mark-Bauer discloses the wireless Internet-enabled device is a wireless telephone (see Bauer col.2, lines 54-60; col.4, lines 30-36; col.6, lines 15-38, using the mobile phone or any wireless device). The same motivation utilized in claim 1 applied equally well to claim 6,25.

**As regarding claim 12 and 29** Mark-Bauer discloses programming said programmable device by associating at least one output character with a corresponding input code and its associated user entry button (see Mark col.3, lines 26-38; col.4, lines 6-45; col.7, lines 27-58, inputting the unique code using the telephone keypad, this unique code associate with the pre-recorded message that store at the service provider, the database at the service provider stores pre-recorded message associated with each individual).



**As regarding claim 13 and 30**, Mark-Bauer discloses associating linguistic phrases with corresponding input codes and the associated user entry buttons (see Mark col.3, lines 26-38; col.4, lines 6-45; col.7, lines 27-58, inputting the unique code using the telephone keypad, this unique code associate with the pre-recorded message that store at the service provider, the database at the service provider stores pre-recorded message associated with each individual).

**As regarding claim 14**, Mark-Bauer discloses receiving said at least one user-specified character from a user input device (see Mark col.3, lines 26-38; col.4, lines 6-45; col.7, lines 27-58, inputting the unique code using the telephone keypad, this unique code associate with the pre-recorded message that store at the service provider, the database at the service provider stores pre-recorded message associated with each individual).

**As regarding claim 16**, Mark-Bauer discloses presenting a programming interface to a user, to facilitate receiving said programming commands (see Bauer col.2, lines 54-60; col.4, lines 30-36; col.6, lines 15-38). The same motivation utilized in claim 1 applied equally well to claim 16 and 33.

**As regarding claim 17-19 and 34-36**, Mark-Bauer discloses relating a set of input codes and corresponding output characters to a user, producing comprises locating a set of input codes and corresponding output characters, corresponding to a

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user determined from said input code (see Mark col.3, lines 26-38; col.4, lines 6-45; col.7, lines 27-58, inputting the unique code using the telephone keypad, this unique code associate with the pre-recorded message that store at the service provider, the database at the service provider stores pre-recorded message associated with each individual).

**As regarding claim 40,41** Mark-Bauer discloses an apparatus for producing user-defined output characters in response to input codes (see Mark col.3, lines 26-38; col.4, lines 6-45; col.7, lines 27-58); plurality of user entry buttons where each user entry button is associated with an input code (see Mark col.3, lines 26-38; col.4, lines 6-45; col.7, lines 27-58), the system comprising a web server operable to establish communications with said web-communicating input device using the World Wide Web (see Bauer col.2, lines 54-60; col.4, lines 30-36; col.6, lines 15-38) and programmed to produce at least one user-specified output character associated with one of the plurality of user entry buttons for use in a field of an e-mail produced by an e-mail server in communication with said web server (see Mark col.3, lines 26-38; col.4, lines 6-45; col.7, lines 27-58), in response to receipt by said web server of an input code associated with the user entry button (see Mark col.3, lines 26-38; col.4, lines 6-45; col.7, lines 27-58), from said web-communicating input device (see Bauer col.2, lines 54-60; col.4, lines 30-36; col.6, lines 15-38). The same motivation was utilized in claim 1 applied equally well to claim 40-41.

**As regarding claim 42-43**, Mark-Bauer discloses said web server and said e-mail server are implemented on a common computer (see Mark col.3, lines 26-38; col.4, lines 6-45; col.7, lines 27-58, also see Bauer col.2, lines 54-60; col.4, lines 30-36; col.6, lines 15-38). Mark-Bauer does not explicitly disclose web server and email server on a separate computer. However the concept of making separation was being held obvious by the court (In re Dulberg, 289 F.2d 522, 523, 129 USPQ 348, 349 (CCPA 1961)) (see MPEP 2143). Therefore, making web server separate from email server is obvious to one with ordinary skill in the art at the time the invention was made.

**As regarding claim 44-45**, Mark-Bauer discloses data communication network is the Internet (see Bauer col.6, lines 63-67).

**As regarding claim 46**, Mark-Bauer discloses the application program providing a user with a prompt for text input (see Mark col.4, lines 31-45, input the text to pre-recorded at the outcall database) at the wireless internet enabled device (see Bauer col.6, lines 33-45, wireless device such as wireless telephone), wherein the input code is received as a response to the prompt at the wireless internet enabled device (see Bauer col.6, lines 16-45) transmitting the response to the application program after the at least one user-specified output character is substituted in place of the received input code for the response (see Bauer col.6, lines 16-45). The same motivation was utilized in claim 1 applied equally well to claim 46.

**As regarding claim 47**, Mark-Bauer discloses wherein the response is display by the application program on the wireless Internet enabled device with the substituted at least one user-specified output character (see Bauer col.6, lines 16-45). The same motivation was utilized in claim 1 applied equally well to claim 47.

**As regarding claims 48-49**, Mark-Bauer discloses the input code exclude a telephone number (see Mark col.7, lines 16-34).

**As regarding claim 50**, Mark-Bauer discloses the input code is not transmitted to the application program (see Bauer col.2, lines 28-67). The same motivation was utilized in claim 1 applied equally well to claim 50.

**As regarding claims 51-55**, the limitations of claims 51-55 are similar to limitations of rejected claims 46-50, therefore rejected for the same rationale.

**As regarding claims 56-60**, the limitations of claims 56-60 are similar to limitations of rejected claims 46-50, therefore rejected for the same rationale.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

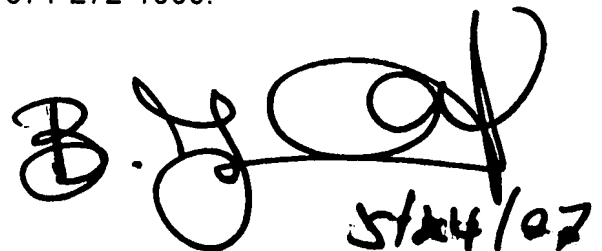
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Duyen M. Doan whose telephone number is (571) 272-4226. The examiner can normally be reached on 9:30am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on (571) 272-3913. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Examiner  
Duyen Doan  
Art unit 2152



BUNJOB JAROENCHONWANIT  
SUPERVISORY PATENT EXAMINER